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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,593	12/31/2003	Albrecht Marhold	Mo 5346D2/LeA 32 314D2	8545

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EXAMINER

OH, TAYLOR V

ART UNIT PAPER NUMBER

1625

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,593

Applicant(s)

MARHOLD ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 7 is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Status of Claims

Claims 3-7 and 12-13 are pending.

Claim 13 has been rejected.

Claims 4-6 and 12 have been objected.

Claims 3 and 7 are allowable.

DETAILED ACTION

Priority

1. It is noted that the instant application is a division of 10/227,310 (08/26/02) abandoned on 7/27/2004, which is a continuation of 09/814,132 (US 6,541,675) filed on 3/21/2001, which is a division of 09/403,263 (US 6,229,040) filed on 10/15/1999, which is a 371 of PCT/EP98/02175 (04/14/1998) .

Drawings

2. None.

Specification

The disclosure is objected to because of the following informalities:.

The term " aluminium chloride" is recited on page 3 , line 23. This chemical name has an improper spelling. Appropriate spelling correction is required.

Claim Objections

Claims 4-6 and 12 are objected to because of the following informalities:

In claims 4-5, there are no periods in the ends of the claims.

Appropriate correction is required.

In claims 4 and 6 , there is the absence of the hyphen "-" in the chemical term " 2,4-dichloro-5fluoro-3-N-hydroxyiminomethyl-benzoic acid" .

Appropriate correction is required.

In claim 12 , the chemical term " 2,4-dichloro-5-fluoro-1,3-dimethylbenzendu" is recited. This chemical name has an improper spelling.

Appropriate spelling correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a catalyst, such as a Lewis acid (e.g. iron chloride or aluminum chloride) does not reasonably provide enablement for all the catalysts known in the art. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use all the catalysts unrelated to the current invention commensurate in scope with the claim.

Furthermore, the instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation.

Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation, citing *Ex Parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence or absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breath of the claims.

In the instant case, the claim encompasses various catalysts. However, applicants' specification provide particular exemplified catalysts such as a Lewis acid (e.g. iron chloride or aluminum chloride). There is uncertainty as to the rest of the catalysts in the different art that would work equally to those described catalysts in the chlorination process. Furthermore, the catalyst compositions represent an unpredictable aspect in the art of organic chemistry . See *Exparte Sizto*, 9 USPQ2d 2081 (Bd. Of App. And Inter. March 1988). Thus, the specification herein have failed to

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provide sufficient working examples to support the use of all kinds of various catalysts.

Therefore, an appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Taylor V. Oh
9/2/15